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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Travis J. Parry et al.

Confirmation No.: 8613

Application No.: 10/625,241

Examiner: Mark R. Milia

Filing Date: July 22, 2003

Group Art Unit: 2625

Title: Method and Systems for Providing Web Content to a Printing Device

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on July 30, 2009 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,

Travis J. Parry et al.

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REPLY BRIEF

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Sir:

This is a Reply Brief under Rule 41.41 (37 C.F.R) in response to the Examiner's Answer of July 30, 2009 (the "Examiner's Answer" or the "Answer"). In Section 10, the Answer contains a response to some of the arguments made in Appellant's brief. Appellant now responds to the Examiner's Answer as follows.

Status of Claims

Under the imposition of a previous Restriction Requirement, claims 7-26 and 38-52 were withdrawn from consideration and cancelled without prejudice or disclaimer. Thus, claims 1-6, 27-37, and 53-58 are pending in the application and stand finally rejected. Accordingly, Appellant appeals from the final rejection of claims 1-6, 27-37, and 53-58.

Grounds of Rejection to be Reviewed on Appeal

The final Office Action raised the following grounds of rejection.

(1) Claims 1-3, 32, 36 and 53 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of U.S. Patent No. 6,113,208 to Benjamin et al. (“Benjamin”) and U.S. Patent App. Pub. No. 2003/0234957 to Ohara (“Ohara”).

(2) Claims 1, 32-34 and 53 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of U.S. Patent No. 6,332,062 to Phillips (“Phillips”) and Ohara.

(3) Claims 4-6 and 37 were rejected under 35 U.S.C. §103(a) over the combined teachings of Benjamin, Ohara and U.S. Patent No. 6,507,762 to Amro et al. (“Amro”).

(4) Claims 27-28 and 54-55 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Phillips, Ohara, and U.S. Patent No. 6,532,351 to Richards (“Richards”).

(5) Claims 29-31 and 56-58 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Phillips, Ohara, Richards, and U.S. Patent App. Pub. No. 2005/0240518 to Ishizuka (“Ishizuka”).

(6) Claim 35 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Phillips, Ohara, and Richards.

According, Appellant hereby requests review of each of these grounds of rejection in the present appeal.

Argument

(1) Claims 1-3, 32, 36 and 53 are patentable over Benjamin and Ohara:

Claim 1:

Independent claim 1 recites:

A method of providing web content to a printing device, said method comprising attaching a memory module storing said web content to a printing device consumable;

wherein said web content comprises content that is included in a web page that is served up by said printing device using an embedded web server.

(Emphasis added).

In contrast, the combination of Benjamin and Ohara does not teach or suggest a method of providing “web content” to a printing device using a memory module attached to a print consumable.

A principal issue with regard to Appellant’s claims is the definition of the term “web content.” Expecting that this would be the case, Appellant included a definition of “web content” expressly in claim 1. Claim 1 specifically recites and defines “web content” as “content that is included in a web page that is served up by said printing device using an embedded print server.” Additionally, the claimed “web content,” as recited within claim 1, is originating from “a memory module” attached to “a printing device consumable.”

In general terms, the subject matter of claim 1 addresses the situation in which a printing device has an embedded web server so that, for example, one can access a web page originating at the printer from any Internet access point. Periodically, the users may want different content to be served up by that web server when accessed remotely. Thus, claim 1 recites a method by which content for that web server, i.e., “that is included in a web page

that is served up by said printing device using an embedded web server,” can be updated by the consumables, such as toner cartridges, that regularly circulate through the printing device.

In contrast, the cited prior art does not provide web content to the printing device that is then served up by the printing device’s embedded web server. Rather, the cited prior art merely teaches providing addresses or URLs to the printing device so that information can be requested from other web servers. These addresses are NOT “web content” within the express meaning of claim 1 because these addresses are merely used to access data and are not “*included in a web page that is served up by said printing device using an embedded web server.*”

According to the Answer, “‘web content’, per the applicant’s specification, may include any information or programming used as, or a part of, a web page *or a link.*” (Answer, p. 16) (emphasis added). This is incorrect and contrary to the express language of claim 1.

Appellant’s claim 1 does not define any “link” as being “web content.” Rather, only content “*included in a web page that is served up by said printing device using an embedded web server*” (claim 1) qualifies as web content. A link that is used to access data and is never included in a web page is NOT “web content” under the express definition in claim 1. Thus, the definition of “web content” adopted by the Answer is unreasonably broad and contrary to the express definition of the term given *in claim 1*. Such a misuse of language cannot support a rejection of Appellant’s claims.

With specific reference to the prior art, Benjamin has nothing whatsoever to do with “web content” that is “*included in a web page that is served up by said printing device using an embedded print server.*” As demonstrated previously, Benjamin teaches storing a printer driver identifier code on a memory chip of an ink cartridge. (Benjamin, col. 3, line 50 to col.

4, line 11). Appellant notes that this “identifier code” is never displayed anywhere. It is never served up as part of a web page.

Additionally, “data read from the memory cartridge can automatically cause the printer's host processor to connect to the manufacturer's Internet website, where the user would have the opportunity of directly downloading an updated driver.” (*Id.*). Yet, again, this “data” for connecting to the manufacturer’s Internet website is merely a web address and is never displayed anywhere. It may be used to request a web page, but is never served up as part of a web page.

Consequently, there is no data on the memory chip taught by Benjamin that qualifies as “web content” under the terms of claim 1. Specifically, there is no data on the memory chip taught by Benjamin that is “web content [comprising] content that is included in a web page that is served up by said printing device using an embedded web server.” (Claim 1).

Ohara does not remedy the shortcomings of Benjamin. Ohara teaches a system in which information, in the form of a print job, is received by a printer over a network connection. (Ohara, Fig. 1; paragraph 0031). The printer comprises a Web server (25) that can provide “a printer function setting page, in which the setting of various functions of the printer 20 can be performed through the network NT, and a print progress monitoring page, which shows progress of a printing operation of a specified print request (print job).” (Ohara, paragraph 0033). Thus, while Ohara does teach a printer with a Web server, Ohara does not teach or suggest any aspect of the claimed method of providing web content to a printing device by “attaching a memory module storing said web content to a printing device consumable; wherein said web content comprises content that is included in a web page that is served up by said printing device using an embedded web server.” (Claim 1).

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Benjamin and Ohara, does not include the subject matter of claim 1, particularly, providing “web content” to a printing device using a “memory module attached to a print consumable.”

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages that were not available in the cited prior art, namely periodically updating a web page served by a printer by simply inserting new print consumables into the printer. (See Appellant’s specification, paragraphs 0022-0024, 0038). Consequently, the cited prior art will not support a rejection of claim 1 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 32:

Independent claim 32 recites:

A consumable for use with a printing device, said consumable comprising:
a printing device consumable;
a memory module attached to said printing device consumable; and
web content stored on said memory module, wherein said web content is included in a web page served up by said printing device using an embedded web server.

(Emphasis added).

As amply demonstrated above, the combination of Benjamin and Ohara does not teach or suggest a consumable which stores web content on memory module attached to a print consumable, where the “web content” is *expressly* defined as being “included in a web page served up by said printing device using an embedded web server.”

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by, Benjamin and Ohara, clearly did not include the subject matter of claim 32. Consequently, the cited prior art will not support a rejection of claim 32 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 53:

Independent claim 53 recites:

A method of providing web content for a printing device, said method comprising:

storing web content on a memory module attached to a printing device consumable;

uploading said web content from said memory module to said printing device when said consumable is installed in said printing device; and

serving up a web page with said printing device using an embedded web server, said web page comprising said web content provided to said printing device with said memory module attached to said printing device consumable.

(Emphasis added).

As amply demonstrated above, the combination of Benjamin and Ohara does not teach or suggest the claimed method of providing web content for a printing device. Claim 53 specifically recites “uploading web content from said memory module from said memory module” and “serving up a web page with said printing device using an embedded web server, said web page comprising said web content.” Importantly, the claimed web content is recited within claim 53 as being stored on a memory module” attached to “a printing device consumable” and then later uploaded to the printing device. The origin of the “web content” from a memory module attached to a printing device consumable provides the significant

advantage of updating web content served by a printing device by simply inserting new print consumables to the printing device.

In sum, as demonstrated above, neither Benjamin nor Ohara, whether taken separately or in combination, teach or suggest a method for providing web content for a printing device by “uploading said web content from said memory module to said printing device” and “serving up a web page with said printing device using an embedded web server, said web page comprising said web content.” (Claim 53). This subject matter is entirely outside the scope and content of the cited prior art.

(2) Claims 1, 32-34 and 53 are patentable over Phillips and Ohara.

Claim 1:

Independent claim 1 recites:

A method of providing web content to a printing device, said method comprising attaching a memory module storing said web content to a printing device consumable;

wherein said web content comprises content that is included in a web page that is served up by said printing device using an embedded web server.

(Emphasis added).

As above, a principal issue in this rejection is the definition of “web content.” If, as argued above, the definition of “web content” expressly included in claim 1 is respected, it will be immediately clear that the cited prior art fails to render obvious the claimed method. In particular, the combination of Phillips and Ohara does not teach or suggest a method of providing “web content” to a printing device using a memory module attached to a print consumable. Phillips appears to suffer from all the same deficiencies as described above with respect to Benjamin.

Specifically, Phillips does not teach or suggest the “web content” as recited by claim 1. Like Benjamin above, Phillips teaches providing a URL that can be used to contact a website and request data, such as a web page. Again, this is clear difference between browsers and servers, between requesting a web page and serving or providing a web page.

According to the Answer, a “URL is interpreted as ‘web content’ per the applicant’s specification.” (Answer, p. 17). Respectfully, the Answer should focus on the language of the claims rather than the “specification.” As demonstrated above, Appellant’s claim 1 does not define any URL or “link” as being “web content.” Rather, only content “*included in a web page that is served up by said printing device using an embedded web server*” (claim 1) qualifies as web content. A URL that is merely used to access data and is never included in a web page is NOT “web content” under the express definition in claim 1. Thus, the definition of “web content” adopted by the Answer is unreasonably broad and contrary to the express definition of the term given *in claim 1*. Such a misuse of language cannot support a rejection of Appellant’s claims.

As demonstrated above, Ohara does not remedy the shortcomings of Philips. While Ohara does teach a printer with a Web server, Ohara does not teach or suggest any aspect of the claimed method of providing web content to a printing device by “attaching a memory module storing said web content to a printing device consumable; wherein said web content comprises content that is included in a web page that is served up by said printing device using an embedded web server.” (Claim 1).

Consequently, neither of the cited prior art references, singly or in combination, teach or suggest the claimed memory module on a consumable that stored web content which is included in a web page served up by the printing device using an embedded web server. This subject matter is clearly absent from the scope and content of the cited prior art.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Phillips and Ohara, does not include the subject matter of claim 1, particularly, providing “web content” to a printing device using a “memory module attached to a print consumable.”

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages that were not available in the cited prior art, namely periodically updating a web page served by a printer by simply inserting new print consumables into the printer. (See Appellant’s specification, paragraphs 0022-0024, 0038). Consequently, the cited prior art will not support a rejection of claim 1 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 32:

Independent claim 32 recites:

A consumable for use with a printing device, said consumable comprising:
a printing device consumable;
a memory module attached to said printing device consumable; and
web content stored on said memory module, wherein said web content is included in a web page served up by said printing device using an embedded web server.

(Emphasis added).

As amply demonstrated above, the combination of Phillips and Ohara does not teach or suggest a consumable which stores web content on memory module attached to a print consumable, where the “web content” is *expressly* defined as being “included in a web page served up by said printing device using an embedded web server.”

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by, Phillips and Ohara, clearly did not include the subject matter of claim 32. Consequently, the cited prior art will not support a rejection of claim 32 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 53:

Independent claim 53 recites:

A method of providing web content for a printing device, said method comprising:

storing web content on a memory module attached to a printing device consumable;

uploading said web content from said memory module to said printing device when said consumable is installed in said printing device; and

serving up a web page with said printing device using an embedded web server, said web page comprising said web content provided to said printing device with said memory module attached to said printing device consumable.

(Emphasis added).

As amply demonstrated above, the combination of Philips and Ohara does not teach or suggest the claimed method of providing web content for a printing device. Claim 53 specifically recites “uploading web content from said memory module from said memory module” and “serving up a web page with said printing device using an embedded web server, said web page comprising said web content.” Importantly, the claimed web content is recited within claim 53 as being stored on a memory module” attached to “a printing device consumable” and then later uploaded to the printing device. The origin of the “web content” from a memory module attached to a printing device consumable provides the significant

advantage of updating web content served by a printing device by simply inserting new print consumables to the printing device.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Phillips and Ohara, does not include the subject matter of claim 53. Specifically, the combination of Phillips and Ohara does not teach a method for providing web content for a printing device by “uploading said web content from said memory module to said printing device” and “serving up a web page with said printing device using an embedded web server, said web page comprising said web content.”

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages with regard to periodically updating a web page served by a printer by insertion of print consumables into the printer. (*See* Appellant’s specification, paragraphs 0022-0024, 0038). Consequently, the cited prior art will not support a rejection of claim 53 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

(3) Claims 4-6 and 37 are patentable over Benjamin, Ohara and Amro:

This rejection should clearly not be sustained for at least the reasons given above in favor of the patentability of the corresponding independent claims.

Claim 4:

Additionally, claim 4 recites “further comprising uploading a web content interface from said memory module to a memory of said printing device.” The Appellant’s specification defines the term “web content interface” as follows.

The web content interface (104) can be uploaded by a printer or printing device and *used to access the web content (103) that remains on the memory module (110)*. The web content interface (104) is stored *as computer-readable instructions* that can be uploaded and executed by a host printer or printing device. The web content interface (104) may be written according to customer specifications. (Appellant’s specification, paragraph 22) (emphasis added).

The final Office Action had conceded that “Benjamin and Ohara do not disclose expressly uploading a web content interface.” (final Office Action, p. 12). Accordingly, the final Office Action cited to Amro a col. 6, lines 12-36. (*Id.*). However, Appellant’s Brief demonstrated that the cited portion of Amro failed to teach or suggest anything relevant to the claimed web content interface.

Apparently seeking a new line of argument, the Answer now argues that “Benjamin disclosed electrical coupling of memory chip 20 with the microprocessor of printer 1 ... thus some type of interface must be present for such communication to take place.” (Answer, p. 18). Appellant agrees. However, that does not mean that the interface present is the claimed “web content interface.” (Claim 4).

Again, Appellant has defined “web content interface” as follows.

The web content interface (104) can be uploaded by a printer or printing device and *used to access the web content (103) that remains on the memory module (110)*. The web content interface (104) is stored *as computer-readable instructions* that can be uploaded and executed by a host printer or printing device. The web content interface (104) may be written according to customer specifications. (Appellant's specification, paragraph 22) (emphasis added).

Clearly, the coupling between the memory chip 20 and microprocessor taught by Benjamin does not include, teach or suggest the defining elements of the claimed "web content interface."

The Answer concludes by noting that "Amro discloses uploading of an interface that provides communication between two devices, in this case [an] appliance and a portable digital device." (Answer p. 18). However, the portable device uploads the interface from the appliance, not from a memory module on a printing device consumable. Moreover, the interface taught by Amro has nothing whatsoever to do with transferring web content. Thus, Amro appears to be entirely inapposite to the subject matter of claim 4.

Amro, alone or in combination with Benjamin and Ohara, clearly does not teach or suggest anything about a web content interface or the specific method step of "uploading a web content interface from said memory module to a memory of said printing device." (Claim 4). To the contrary, the subject matter of claim 4 is clearly outside the scope and content of the cited prior art. For at least these additional reasons, the rejection of claim 4 and its dependent claim should not be sustained.

Claim 37:

Claim 37 recites "a web content interface stored on said memory module which, when uploaded to a printing device, allows access and use of said web content on said memory module." As demonstrated above, the combination of Benjamin, Ohara and Amro clearly

does not teach or suggest the claimed web content interface that “allows access and use of said web content on said memory module.” There is no interface with this functionality taught or suggested in any of the cited prior art references. For at least these additional reasons, the rejection of claim 37 and its dependent claim should not be sustained.

(4) Claims 27-28 and 54-55 are patentable over Phillips, Ohara, and Richards.

This rejection should not be sustained for at least the same reasons given above in favor of the patentability of the independent claims.

Additionally, claims 27 and 54 recite “receiving data specifying desired web content from a purchaser of a printing device consumable.” The final Office Action erroneously asserts that Richards teaches “receiving data specifying desired web content from a purchaser of a printing device consumable.” (final Office Action, p. 13).

The Answer now explains that “Richards states that information such as the identity of the end user intended to receive the module in the mail, or a particular service contract number under which the packaged module is sent can be stored in the customer replaceable unit monitor (CRUM) memory that is attached to a consumable, *which is information tied to a purchaser of a printing device.*” (Answer, p. 19) (emphasis added).

However “*information tied to a purchaser of a printing device*” is not at issue. Claims 27 and 54 recite “receiving data specifying desired web content from a purchaser of a printing device consumable.” This is not data tied to a purchaser of a printing device, but data that specifies web content to be included with a printing device consumable as selected by a purchaser of this consumable. Merely having the identity or service contract number of a purchaser, as taught by Richards, is nowhere near the same thing as allowing that purchaser to identify *web content* to be included with a consumable.

As Appellant has noted previously, receiving data specifying desired web content from a purchaser of a printing device consumable provides the benefit of allowing the purchaser to specify web content customized for the purchaser's organization or needs. For example, the web content specified by the purchaser could be a customized web content interface that is written according to the customer specifications. (Appellant's specification, paragraph 0022).

Thus, for at least the additional reasons given above, the combination of Phillips, Ohara, and Richards does not teach or suggest the claimed subject matter of independent claims 27 and 54. Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, as amply demonstrated above, the scope and content of the prior art, as evidenced by Phillips, Ohara, and Richards, did not include the subject matter of Applicant's claims 27 and 54. For at least these reasons, the rejection of claims 27 and 54 should not be sustained.

(5) Claims 29-31 and 56-58 are patentable over Phillips, Ohara, Richards, and Ishizuka.

This rejection should not be sustained for at least the same reasons given above in favor of the patentability of the independent claims.

Additionally, claims 29 and 56 recite "receiving data specifying said web content from a purchaser comprises receiving said web content through a terminal at a consumables sales facility." As demonstrated above, the cited prior art is entirely silent on the issue of allowing a purchaser to specify web content to be included with a consumable.

According to the Answer, “Ishizuka was used to show that it is known in the art that order consumables can take place at a terminal at a consumables sales facility.” (Answer, p. 19). If that is all that Ishizuka teaches, it clearly cannot remedy the deficiencies of the other cited prior art which have been demonstrated above. For at least these additional reasons, the rejection of claims 29 and 56 should not be sustained.

(6) Claim 35 is patentable over Phillips, Ohara and Richards.

This rejection should not be sustained for at least the same reasons given above in favor of the patentability of the independent claims.

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Rejection of January 30, 2009 is respectfully requested.

Respectfully submitted,

DATE: September 30, 2009

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